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FRANK C. NICHOLAS (33,983)
Name of applicant, assignee or registered representative

/FRANK C. NICHOLAS/
Signature

January 24, 2007
Date of Signature

PATENT
Case No.: AUS920000801US1
(9000/11)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:)	
)	
STEVEN M. FRENCH, ET AL.)	Examiner: NGUYEN, THANH
)	
Serial No.: 09/731,624)	
)	Group Art Unit: 2144
Filed: DECEMBER 7, 2000)	
Title: METHOD AND SYSTEM FOR)	
GENERATING A LIST OF OPERATING)	
SYSTEMS FOR A TARGET DEVICE)	

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A holding of abandonment issued December 29, 2006. This notice is erroneous, as Appellants previously timely filed a supplemental appeal brief, on September 26, 2005 and also on November 17, 2005, and filed a request for the status of the application on May 18, 2006.

The Examiner's September 9, 2005 action attempted to reopen prosecution after Appellant's appeal – however, the Examiner asserted no new grounds of rejection, and therefore Appellants opted to maintain their appeal, as was their right under §41.41 of the rules. §41.41 provides that the filing of a reply brief acts as a request that the appeal be maintained.

The attached Exhibit A is a printout of PAIR illustrating that the PTO did in fact receive the brief filed on §41.41 on both September 26, 2005, and again on November 17, 2005. In addition, PAIR clearly notes that the status request (no response was issued) was received on May 18, 2006. Clearly, this matter is not abandoned despite the errors in the status noted by PAIR.

Additionally, were the §41.41 brief noncompliant with the rules in any fashion, the Examiner must notify the Appellant, as mandated by §41.41(b). Since no such notification was issued, Appellant is confident that the brief is fully compliant.

Indeed, Comment 65 to the new rules initiated in the Fall of 2004 specifically addresses the precise situation here – the Examiner's response to the filed Appeal Brief failed to contain any true new grounds of rejection, and Appellants did not wish to reopen prosecution. As Comment 65 notes:

One comment suggests that allowing the examiner to institute a new ground of rejection in the examiner's answer is unfair to the appellant and the examiner should be required to reopen prosecution.

Answer: If the examiner institutes a new ground of rejection in the examiner's answer, then the appellant has two months to either request that prosecution be reopened by filing a reply under § 1.111 or file a reply brief under § 41.41, which would act as a request that the appeal be maintained. Accordingly, although the examiner may in limited situations institute a new ground of rejection on appeal, the appellant has the right to request that prosecution be reopened. An appellant may not wish to have

prosecution reopened if the new ground of rejection is similar to a prior rejection or if the evidence of record is sufficient to address the rejection. Moreover, reopening prosecution may prolong examination without any benefit to the appellant.

Therefore, Appellant asks that the abandonment of this application be withdrawn, and that this matter pass to the Board for a prompt ruling on its appeal of the Examiner's erroneous rejections.

SUMMARY

The Appellants respectfully request withdrawal of the holding of abandonment, maintenance of their appeal, and submit that claims 1-27 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **January 24, 2007**

Respectfully submitted,
STEVEN M. FRENCH, *et al.*

/FRANK C. NICHOLAS/

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EXHIBIT A

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09/731,824

Method and system for generating a list of operating systems for a target device



Application Transaction Data	Image File History	Published Documents	Publication Dates	Address & Attorney/Agent
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This application is officially maintained in electronic form. To View: Click the desired Document Description. To Download and Print: Check the desired document(s) and click StartDownload.

Mail Room Date	Document Description	Page Count	Select All	Start Download	Clear All
05-18-2006	Request for status of Application	5	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
11-17-2005	Appeal Brief Filed	26	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
09-26-2005	Appeal Brief Filed	24	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
09-09-2005	Non-Final Rejection	12	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
09-09-2005	List of references cited by examiner	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
09-09-2005	Search information including classification, databases and other search related notes	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
09-09-2005	Index of Claims	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
08-17-2005	Examiner's search strategy and results	5	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
06-03-2005	Appeal Brief Filed	24	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
04-11-2005	Notice of Appeal Filed	2	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
01-14-2005	Final Rejection	12	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
01-14-2005	Index of Claims	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
08-16-2004	Fee Worksheet (PTO-06)	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
08-16-2004	Fee Worksheet (PTO-06)	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
08-16-2004	Amendment - After Non-Final Rejection	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
08-16-2004	Claims	6	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
08-16-2004	Applicant Arguments/Remarks Made in an Amendment	4	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
08-16-2004	Transmittal to TC	2	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
08-06-2004	Examiner Interview Summary Record (PTOL - 413)	4	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
05-14-2004	Non-Final Rejection	9	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
05-14-2004	List of references cited by examiner	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
05-14-2004	List of References cited by Applicant and considered by examiner	2	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
04-22-2004	Examiner's search strategy and results	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
04-20-2004	Examiner's search strategy and results	2	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
04-04-2004	Examiner's search strategy and results	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
12-10-2001	Information Disclosure Statement (IDS) Filed	2	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
04-27-2001	Information Disclosure Statement (IDS) Filed	2	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
12-07-2000	Issue Information, including classification, examiner, name, claim, renumbering, etc.	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

12-07-2000	Search information including classification, databases and other search related notes	1	<input type="checkbox"/>
12-07-2000	Index of Claims	1	<input type="checkbox"/>
12-07-2000	Transmittal of New Application	1	<input type="checkbox"/>
12-07-2000	Authorization for Extension of Time all replies	1	<input type="checkbox"/>
12-07-2000	Drawings	4	<input type="checkbox"/>
12-07-2000	Specification	15	<input type="checkbox"/>
12-07-2000	Claims	5	<input type="checkbox"/>
12-07-2000	Abstract	1	<input type="checkbox"/>
12-07-2000	Oath or Declaration filed	3	<input type="checkbox"/>
12-07-2000	Bibliographic Data Sheet	1	<input type="checkbox"/>
12-07-2000	Fee Worksheet (PTO-06)	1	<input type="checkbox"/>
12-07-2000	Fee Worksheet (PTO-05)	1	<input type="checkbox"/>
12-07-2000	Transmittal of New Application	1	<input type="checkbox"/>
12-07-2000	Specification	15	<input type="checkbox"/>
12-07-2000	Claims	5	<input type="checkbox"/>
12-07-2000	Abstract	1	<input type="checkbox"/>
12-07-2000	Drawings	4	<input type="checkbox"/>
12-07-2000	Oath or Declaration filed	3	<input type="checkbox"/>

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